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ERNEST A. BEUTLER,
ATTORNEY AT LAW
10 RUE MARSEILLE
NEWPORT BEACH CA 92660

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OFFICE OF PETITIONS

In re Application of	:	
Masaoka, et al.	:	
Application No. 10/605,843	:	DECISION
Filed/Deposited: 30 October, 2003	:	
Attorney Docket No. SIMTEK6701	:	

This is a decision on the petition filed on 1 November, 2008, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition to withdraw the holding of abandonment under 37 C.F.R. §1.181 is **GRANTED**.

As to the Request to Withdraw
the Holding of Abandonment

Petitioners always are directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness requirements for relief under 37 C.F.R. §1.181.

BACKGROUND

The record reflects that:

The Board of Patent Appeals and Interferences (BPAI) mailed its decision in the instant matter on 21 May, 2008, affirming in part and reversing in part the rejections by the Examiner, and the BPAI provided that no extensions of time were available under 37 C.F.R. §1.136(a) in reply to the decision.

On 3 June, 2008, Petitioner filed a reply in the form of an amendment.

On 9 June, 2008, the Examiner mailed a Notice to the Petitioner indicating that the amendment was not entered and that, pursuant to 37 C.F.R. §1.198, Petitioner would have to file a request for continued examination (RCE), fee and submission under 37 C.F.R. §1.114. Further, the

Examiner set a reply period of one month, not less than 30 days, and explicitly stated that extensions of time under 37 C.F.R. §1.136(a) were not available.

The application went abandoned by operation of law after midnight 9 July, 2008.

On 1 August, 2008, the Office mailed a Notice of Abandonment.

On 5 August, 2008, Petitioner filed a petition and amendment with a copy of an electronic acknowledgement reflecting a 16 June, 2008, filing of papers that otherwise do not appear in the image file wrapper (IFW)—stated another way, the IFW does not appear at this writing to contain a copy of papers filed on 16 June, 2006—however, a fee transaction in the PALM database for the instant application indicates a credit card payment of \$210.00.

On 27 August, 2008, Petitioner filed a petition, however, his one- (1-) paragraph petition insufficiently detailed (*see*: MPEP §711.03(c)) the events/transactions Petitioner believed took place and some of the papers to which Petitioner referred in his petition did not appear to have been submitted with the petition. While it appeared that Petitioner failed to file a timely and proper reply under the rules as discussed hereinabove, the matter was clouded by the fact that Petitioner provided none of the documentation and narrative (statement/showing) as set forth at MPEP §711.03(c)(I). Thus, the petition was dismissed on 29 September, 2008.

On 1 November, 2008, Petitioner re-advanced his petitions of 5 and 27 August, 2008, with no more showing than before, however, it now is noted that it appears that the materials contended by Petitioner as having been timely filed are in fact set off by the Office in the Image File Wrapper (IFW) as “Closed”—a condition analogized in the times of paper files as materials having been expunged. Thus, the Petitioner’s reply appears to have been timely. Petitioner is cautioned, however, that the requirements set forth at MPEP §711.03(c)(I) are controlling as to petitions seeking relief pursuant to 37 C.F.R. §1.181, and Petitioner should not ignore those explicit requirements.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner’s duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994). And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.^{2,3}

Moreover, the Office has set forth in the Commentary at MPEP §711.03(c)(I) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

Allegations as to the Request to Withdraw the Holding of Abandonment

The record evidences a satisfactory showing of the requirements under the Rule.

CONCLUSION

The petition as considered under 37 C.F.R. §1.181 is **granted**, and the 1 August, 2008, Notice of Abandonment is **vacated**.

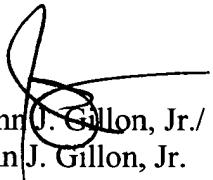
The instant application is released to the Technology Center/AU (TC/AU) 3747 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

² See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

³ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a). And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.